

**IN THE MATTER OF AN OPPOSITION
by Colgate-Palmolive Canada Inc.
and Colgate-Palmolive Company
to application no. 871,372 for the mark
TWISTNBRUSH & Design filed by
Makram H. Abdel Shaheed**

On March 6, 1998 the applicant Makram H. Abdel Shaheed filed an application to register the trade-mark TWISTNBRUSH & Design, illustrated below,



based on proposed use in Canada in association with

toothbrush with a built in toothpaste dispenser.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated January 13, 1999 and was opposed by Colgate-Palmolive Canada Inc. and Colgate-Palmolive Company on May 13, 1999. The Registrar forwarded a copy of an amended statement of opposition, dated July 9, 1999, to the applicant on July 29, 1999. The applicant was granted a retroactive extension of time to file and serve his counter statement (see the Board order dated September 5, 2000), which the applicant effected on October 24, 2000.

The grounds of opposition are pleaded succinctly and are shown in full below.

1. Section 38(2)(a)

The application does not comply with the requirements of sub-section 30(e). More particularly, the Applicant did not in fact intend to use the trade-mark in Canada in association with the wares, by itself or through a licensee, or by itself and through a licensee, as of the filing date of the application, or did not intend to use the mark as a trade-mark, as of the filing date of the application.

2. Section 38(2)©)

The Applicant is not the person entitled to registration of the trade-mark TWISTNBRUSH DESIGN by virtue of s. 16(3)(b). More particularly, the trade-mark TWISTNBRUSH DESIGN was, at the date of the application was filed, and is, confusing with the Opponents' trade-mark COLGATE TWISTER, in respect of which an application for registration has been previously filed in Canada, namely, Application Serial No. 864,692

The opponents' evidence consists of the affidavit of Jacinta Michelle de Abreu. Ms. de Abreu's affidavit merely serves to introduce into evidence a copy of the first opponent's (that is, Colgate-Palmolive Canada Inc.) trade-mark application no. 864,692 for the mark COLGATE TWISTER covering the wares "toothbrushes" relied on in the statement of opposition. The

applicant elected not to file evidence. Both parties submitted a written argument and both were represented at an oral hearing. As the second opponent has not evidenced why it should have standing in this proceeding, I will henceforth refer to the first opponent as “the opponent.”

The opponent concedes that it has not submitted any evidence in support of the first ground of opposition. Accordingly, the first ground is rejected because the opponent has not met the evidential onus on it to put the first ground into issue. Thus, the sole remaining ground of opposition alleges non-entitlement of the applicant pursuant to Section 16(3)(b) of the *Trade-marks Act*. As required by Section 16(4) of the *Act*, and as evidenced by a certified copy of application no. 864,692 relied on by the opponent in the statement of opposition, application no. 864,692 was (i) filed on December 18, 1997, that is, before the date of filing of the applied for mark, and (ii) pending as of January 13, 1997, that is, at the date of advertisement of the applied for mark.

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark TWISTBRUSH & Design and the mark COLGATE TWISTER. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the

marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.). The material time to assess the issue of confusion with respect to Section 16(3)(a) is the date of filing of the application namely March 6, 1998 as stipulated in the *Act*.

The opponent's mark COLGATE TWISTER possesses a fair degree of inherent distinctiveness owing mostly to the component TWISTER which has no direct connection to the associated wares namely, toothbrushes. In the absence of other circumstances, the first component COLGATE would likely be perceived as a surname and therefore it contributes little to the inherent distinctiveness of the mark as a whole: see, for example, *Sarah Coventry, Inc. v. Abrahamian* (1984), 1 C.P.R.(3d) 238 at 240 (F.C.T.D.). However, the parties are in agreement that I may take judicial notice that the term COLGATE is a well known house-mark indicating a particular source for oral hygiene products. The applied for mark TWISTNBRUSH & Design possesses a fair degree of inherent distinctiveness owing mostly the component TWIST. The second component BRUSH is of course descriptive of the associated wares and therefore adds little to the distinctiveness of the mark as a whole. The rectangular background for the mark also adds little to the distinctiveness of the mark as a whole. No acquired reputation, nor length of time in use, can be accorded to either mark. The nature of the parties' wares are very similar and

therefore the expectation is that the parties' wares would travel through the same channels of trade. Further, as noted by the opponent, the parties' wares may be expected to be sold side by side. The parties' marks resemble each other visually, aurally and in ideas suggested owing to the component TWIST featured in each mark.

The main thrust of the applicant's argument is that (i) the first component of a mark is the most important for distinguishing between marks and that (ii) the first component of the opponent's mark, that is, COLGATE, is very different from the first component of the applied for mark, that is, TWIST. From those premises counsel for the applicant concludes that there is no likelihood of confusion between the marks in issue. Despite the cogent and comprehensive arguments put forward by counsel for the applicant, I do not agree with the conclusion. In my view, the component TWISTER in the opponent's mark is a prominent rather than a subordinate feature of the mark COLGATE TWISTER. The marks in issue must be considered in their entireties and the second component TWISTER cannot be ignored. The issue of confusion must be decided as a matter of first impression and imperfect recollection and, in the present case, in the context that (i) the house-mark COLGATE is already well known to the public and (ii) the component TWISTER is a distinctive feature of the opponent's mark. It appears to me that the ordinary consumer, when confronted with the applicant's wares sold under the mark TWISTNBRUSH & Design, would have every reason to assume the applicant's wares are approved, licensed or sponsored by the owner of the COLGATE house mark. It follows that the trade-marks in issue are confusing: see *Glen-Warren Productions Ltd. v. Gertex Hosiery Ltd.*

(1990), 29 C.P.R.(3d) 7 at 12 (F.C.T.D.).

Having regard to the above, the subject application is refused.

DATED AT GATINEAU, QUEBEC, THIS 8th DAY OF FEBRUARY, 2005.

Myer Herzig,
Member,
Trade-marks Opposition Board